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BLAKELY SOKOLOFF TAYLOR & ZAFMAN				
1279 Oakmead Parkway				
Sunnyvale, CA 94085-4040				
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANTHONY A. SHAH-NAZAROFF, JEAN M. GOLDSCHMIDT
IKI, KENNETH ALAN MOORE, and CHRISTOPHER D. WILLIAMS

Appeal 2010-005646
Application 09/580,305
Technology Center 2400

Before, CARL W. WHITEHEAD, JR., GREGORY J. GONSALVES and
ANDREW J. DILLON *Administrative Patent Judges*.

WHITEHEAD, JR., *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants are appealing claims 1-6, 8-16, 18-20, 25, and 26. Appeal Brief 4. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

We affirm.

Introduction

The invention is directed to a method and apparatus for selecting/receiving upgraded media features for programming transmissions. Appeal Brief 4.

Illustrative Claim

1. A method comprising:

receiving, by a server system, a selection to buy an upgraded media feature for a programming transmission from a client system via a first communication media;

automatically coordinating purchase, by the server system, of the upgraded media feature for the programming transmission with one of a plurality of programming transmission sources via a second communication media, the first communication media different than the second communication media; and

automatically coordinating provision, by the server system, of the upgraded media feature for the programming transmission, the programming transmission and upgraded media feature to be provided from the one programming transmission source to the client system via a third communication media, the third communication media different than the first and second communication media.

Rejection on Appeal

Claims 1-6, 8-16, 18-20, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Majeti (U.S. Patent Number 5,512,935; issued April 30, 1996) and Rothblatt (U.S. Patent Number 6,105,060; issued August 15, 2000). Answer 3-7.

Issue on Appeal

Do Majeti and Rothblatt, either alone or in combination, disclose receiving a selection to buy an upgraded media feature, automatically coordinating the purchase of the upgraded feature and automatically coordinating provision of the upgraded media feature?

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' arguments that the Examiner has erred. We disagree with Appellants' conclusions. We concur with the findings and reasons set forth by the Examiner in the action from which this appeal is taken and the reasons set forth by the Examiner in the Answer in response to Appellants' Appeal Brief. However, we highlight and address specific findings and arguments for emphasis as follows.

Appellants argue that neither Majeti nor Rothblatt teach or suggest the claimed limitations as recited in claim 1:

receiving, by a server system, a selection to buy an upgraded media feature for a programming transmission

from a client ..."; "automatically coordinating purchase ... of the upgraded media feature for the programming transmission with one of a plurality of programming transmission sources via a second communication media ..."; and "automatically coordinating provision ... of the upgraded media feature for the programming transmission, the programming transmission and upgraded media feature to be provided from the one programming transmission source to the client system

Appeal Brief 5.

Appellants also argue that Majeti teaches that an alert can be sent by a service provider to a user's computer system and to a user's television in tandem with television programming. Appeal Brief 6 (quoting Majeti column 2, lines 53-56). Appellants conclude that Majeti fails to teach or fairly suggest receiving an upgraded media feature for a programming transmission because Majeti merely teaches the transmission of information. Appeal Brief 6.

Appellants contend:

Rothblatt, relied on in combination with Majeti, similarly fails to teach these recitations [*sic*]. Rothblatt is merely [*sic*] relied upon by the Examiner to teach or suggest the purchasing aspects of the instant claim. Consequently, even when Majeti is viewed in combination with Rothblatt the two fail to teach or suggest the recitations of the instant claim.

Appeal Brief 8.

The Examiner finds that Majeti discloses or fairly suggest the claim limitations in question and that Majeti only fails to teach that the upgraded media feature are purchased by the client. Answer 3-5. Consequently, as

Appellants noted (Appeal Brief 8), the Examiner relies upon Rothblatt to address Majeti's deficiency. Answer 5.

We find Appellants' arguments are predicated on non-functional descriptive material (i.e., the type or content of the claimed programming transmission). Appeal Brief 5. Given the support in Appellants' Specification (describing upgraded media features as providing digital transmissions, broadcasts from a view on demand broadcast source or a wide range of broadcast resources, pages 6-7), we conclude that the claimed "upgraded media feature for a programming transmission" cover audio and/or video material that is "useful and intelligible only to the human mind." See *In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994) (quoting *In re Bernhart*, 417 F.2d 1395, 1399 (CCPA 1969)) (distinguishing such claim limitations from claim limitations defining functional characteristics).

The *informational content* of **non-functional descriptive** material is not entitled to weight in the patentability analysis. See *In re Lowry*, 32 F.3d 1579, at 1583 (Fed. Cir. 1994) ("Lowry does not claim merely the information content of a memory Nor does he seek to patent the content of information resident in a database."). See also *Ex parte Nehls*, 88 USPQ2d 1883, 1887-90 (BPAI 2008) (precedential); *Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005) (informative) (Federal Circuit Appeal No. 2006-1003, *aff'd*, Rule 36 (June 12, 2006)); *Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 2005) (informative), *aff'd*, 191 Fed. Appx. 959 (Fed. Cir. 2006).

Here, the informational content of the claimed "upgraded media feature for a programming transmission" represent nonfunctional descriptive material that is entitled to no weight in the patentability analysis. In particular, the claimed "upgraded media feature for a programming

transmission” are not positively recited in representative claim 1 as changing or altering the machine or computer so as to impart functionality (i.e., the “upgraded media feature for a programming transmission” are not executable instructions).

Further, the claim 1 recites, “a selection to buy an upgraded media feature for a programming transmission from a client system via a first communication media.” We find this limitation pertains to what the occupant, i.e., a human being, does – receive data. We note that the human being can choose to receive the upgraded media feature, which we find to be purely a mental process. That is, though Appellants argue that the system has the ability to receive the upgraded media feature, in actuality, the action to receive upgraded media feature stems from the occupant in the claim and not by the system in the claim.

Consequently, we do not find Appellants’ arguments to be persuasive because the type of transmission does not modify the way the data is received by the occupant and therefore the type of data received is merely descriptive of the data and, without relating functionally to the receipt of the data, the claims limitations are considered to be non-functional descriptive material and are not given patentable weight for the reasons stated above. Thus, providing the claims their broadest reasonable interpretation, the claims only require a system to transmit information or data to a system and the cited prior art (Majeti and Rothblatt) discloses transmission of information or data to a system. Answer 3-5.

We sustain the Examiner’s rejection of independent claim 1, as well as independent claims 5, 14, 18, 25 and 26 that are commensurate in scope and

argued together. *See* Appeal Brief 8. We also sustain the Examiner's rejections of claims 2-6, 9-13, 15, 19 and 20 that are dependent therefrom.

DECISION

The rejection of claims 1-6, 8-16, 18-20, 25, and 26 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv). *See* 37 C.F.R. § 41.50(f).

AFFIRMED

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